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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,996	04/08/2004	Nicholas A. Matiash	29759/ITW-14675	9049
23482	7590	10/24/2006	EXAMINER	
WILHELM LAW SERVICE, S.C. 100 W LAWRENCE ST THIRD FLOOR APPLETON, WI 54911			KERNS, KEVIN P	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,996	<b>Applicant(s)</b> MATIASH ET AL.	
	<b>Examiner</b> Kevin P. Kerns	<b>Art Unit</b> 1725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-29, 31-36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-29, 31-36 and 38-40 is/are rejected.
- 7) ☒ Claim(s) 8, 23 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 and 04 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In this instance, the amended abstract of October 4, 2006 is not provided on a separate sheet.

### ***Claim Objections***

2. Claims 8, 23, and 36 are objected to because of the following informalities: in claim 8, 3<sup>rd</sup> and 4<sup>th</sup> lines, insert "a" before "magnitude" for clarity. In claim 23, 1<sup>st</sup> line, delete "of" before "rim". In claim 36, 2<sup>nd</sup> line, "Claim 31" should be replaced by "Claim 35", to be in agreement with similar claims 16 and 29. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1725

4. Claims 9, 10, and 18-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the base body surface". There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the remaining diameters". There is insufficient antecedent basis for this limitation in the claim.

Claim 22 recites the limitation "said at least one elevated wire interface". There is insufficient antecedent basis for this limitation in the claim. It is suggested to change the claim dependency from "Claim 18" to "Claim 19" to obtain proper antecedent basis.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 18, 25, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaputis (US 4,068,106).

Shaputis discloses a welding apparatus that includes a wire feeder and drive feed roller assembly, in which the drive roller assembly includes one or more drive rolls adapted to feed weld wire 12 having a predetermined diameter, with the drive roll(s) including opposing first and second sides defining a width dimension therebetween (Figures 2-4), thus defining drive roll body/bodies between the first and second sides; an outer circumferential body surface in the form of multiple (first, second, and third) circumferentially-extending grooves/channels/recesses (52,74) of angular cross-section corresponding to a diameter of weld wire 12 about a periphery of the drive roll body between the first and second sides; and a plurality of rims (elevated areas above the grooves/channels/recesses (52,74) extending radially outwardly from and along a major circumferential portion of the outer circumferential body surface), with the rims defining generally arcuate profiles at their outermost surfaces 72 and a diameter that is greater than remaining diameters (of the grooves/channels/recesses) measured along the width of the drive roll bodies (abstract; column 1, lines 51-68; column 2, lines 1-32 and 54-68; column 3, line 1 through column 4, line 47; and Figures 2-5).

7. Claims 1-16, 18-29, 31-36, and 38-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bobeczko et al. (US 6,557,742).

Bobeczko et al. disclose a drive roller for a wire feeding mechanism, in which the drive roller includes a plurality of drive rolls 34 adapted to feed weld wire W having a predetermined diameter from a wire feeding mechanism 10 to a welding gun G, with the drive rolls 34 including opposing first and second sides defining a width dimension

Art Unit: 1725

therebetween (Figures 5A, 6A, and 7A), thus defining drive roll body (bodies) between the first and second sides; an outer circumferential body surface in the form of horizontal drive roll body surfaces above first and second circumferentially-extending grooves 96 (Figure 7A) of angular cross-section corresponding to weld wire W about a periphery of the drive roll body between the first and second sides; at least one elevated wire interface, which are separated from each other in Figure 7A, in the form of flexible cover 36 with a cylindrical outside surface 48 provided over drive roll 34 (Figures 5A, 6A, and 7A) that conveys weld wire W and is displaced radially outwardly from the outer circumferential body surface, in which use of two separate elevated wire interfaces (Figure 7A) would define a channel therebetween and would define circumferential peaks (at the upper tangential surfaces of contact with the weld wire W), while forming an arcuate groove (at the lowermost portion of contact with the weld wire W); and a plurality of rims (areas above the grooves 96; it is noted that these grooves are interpreted as the "recesses" of independent claim 31) adjacent the vertices of the horizontal drive roll body surfaces at a base body surface of the drive rolls), with the rims defining generally planar profiles adjacent the vertices and a diameter that is greater than remaining diameters (within the grooves, or recesses of independent claim 31) measured along the width of the drive roll bodies (abstract; column 2, lines 54-67; column 3, line 1 through column 4, line 31; column 5, line 19 through column 9, line 42; and Figures 1, 5, 5A, 6, 6A, 7, and 7A).

***Response to Arguments***

8. The examiner acknowledges the applicants' amendment and replacement drawing sheet received by the USPTO on October 4, 2006. The replacement drawing sheet overcomes prior objections to the drawings. The amendments to the abstract, specification, and claims overcome prior objections to the abstract, specification, and claims. However, the amended abstract is not provided on a separate sheet (see above section 1). In addition, new claim objections and 35 USC 112, 2<sup>nd</sup> paragraph rejections have been raised (see above sections 2 and 4). With the exception of the Shaputis reference, all prior 35 USC 102(b) rejections have also been overcome by the claim amendments. The applicants have cancelled claims 17, 30, and 37, while adding new claims 38-40. Claims 1-16, 18-29, 31-36, and 38-40 are currently under consideration in the application.

9. Applicants' arguments with respect to claims 1-37 (now claims 1-16, 18-29, and 31-40) have been considered but are moot in view of the new ground(s) of rejection.

It is noted that the applicants' amendments to independent claim 18 are not sufficient to overcome a portion of the 35 USC 102(b) rejections in view of the Shaputis reference for the (revised) reasons set forth in above section 6.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571)

Art Unit: 1725

272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kevin P. Kerns *Kevin Kerns 10/20/06*  
Primary Examiner  
Art Unit 1725

*KPK*  
kpk  
October 20, 2006